

REMARKS

Claims 1-18 are pending in this application. By this Amendment, claims 1 and 10 are amended. The amendments introduce no new matter. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed during the December 8, 2006 personal interview with the Examiner; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection and in light of the Examiner's suggestions during the personal interview. Entry of the amendments is thus respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Ly during the October 2, 2006 telephonic interview and December 8, 2006 personal interview. Applicant's separate record of the substance of the interviews is incorporated into the following remarks.

The Office Action rejects claims 1 and 10 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed. This rejection was discussed during the December 8, 2006 personal interview with the Examiner. Agreement was reached by amending the claims to overcome the 35 U.S.C. §112, second paragraph rejection. The amendments to claims 1 and 10 are taken in light of this agreement. Support for the amendments can be found at least on page 13 of the specification.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 10 under 35 U.S.C. §112, second paragraph, is respectfully requested.

The Office Action rejects claims 1 and 10 under 35 U.S.C. §101 as lacking a useful tangible result. This rejection is respectfully traversed. This rejection was discussed during the December 8 personal interview. The Examiner indicated that, based on the wording of the claims, it was unclear whether the access control was performed on the basis of the access right. Without conceding the propriety of this interpretation, claims 1 and 10 are amended to clarify that the access control is performed on the basis of the access right. As such, performing access control constitutes a tangible result. In light of this discussion, the Examiner agreed that the proposed clarifying amendments to claims 1 and 10 overcome the 35 U.S.C. §101 rejection, pending further review.

Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 10 under 35 U.S.C. §101 are respectfully requested.

The Office Action rejects claims 1-18 under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2002/0120858 to Porter et al. (hereinafter "Porter") in view of U.S. Patent Application Publication No. 2004/0199765 to Kohane et al. (hereinafter "Kohane"). This rejection is respectfully traversed.

Porter does not teach, nor can it reasonably be considered to have suggested, all the features attributed to it by the Office Action. Further, the combination of Porter and Kohane is unreasonable.

The Office Action asserts that Porter teaches a method comprising, among other features, a step of setting an access right in association with a retrieval condition. However, Porter does not teach, nor can it reasonably be considered to have suggested, such a feature. Access control to stored documents in Porter is based on access rights assigned to the document.

Claim 1 recites, among other features, defining a retrieval condition for retrieving an object, the retrieval condition being defined based on at least one attribute of the object, and

setting an access right in association with the retrieval condition. Claim 10 recites similar features. Aspects of an embodiment of such features are depicted in Fig. 2.

Porter teaches a retrieval condition being used to identify one or more documents. The user's access to each of these documents in Porter is then individually verified by the separate security subroutine (see paragraph [0083] of Porter). The security subroutine references the access rights of the document, which were set when the document was created, against an access control entry/list (see paragraph [0075]). As such, the "access right" to any given document is set before the retrieval condition is set. Therefore, it cannot reasonably be considered that the access right in Porter is set in association with the retrieval condition. The access right is set by the document creator, irrespective of any corresponding retrieval condition.

Further, the Office Action has not provided sufficient motivation for combining Porter and Kohane. The Office Action concedes that Porter does not teach performing access control, in response to a request, for the object matching retrieval condition and identifier on the basis of the access right. The Office Action then asserts that "[o]ne having ordinary skill in the art would have found it motivated to utilize the use of controlling access to data objects on the Internet, thereby helping the object owner having authorized to access his/her own the object over the Internet."

The conclusory statements regarding obviousness to combine Porter and Kohane do not meet the articulated standard for proving that there is a teaching, suggestion or motivation in the prior art to combine these references in the manner suggested by the Office Action. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.)

(quoting *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002), and *In re Rouffet*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998)). This standard is not met here.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant respectfully submits that the rejection of at least independent claims 1 and 10 is improper in view of at least MPEP §2143.01 because the Office Action lacks the required specific objective evidence of a teaching, suggestion or motivation in the prior art for one of ordinary skill to combine these references in the manner suggested.

For at least these reasons, the applied prior art references are not combinable in the manner suggested and any permissible combination of the applied prior art references cannot reasonably be considered to teach, or to have suggested, all of the combinations of features positively recited in independent claims 1 and 10. Additionally, claims 2-9 and 11-18 are also neither taught, nor would they have been suggested, by the applied prior art references for at least the respective dependence of these claims, directly or indirectly, on allowable independent claims 1 and 10, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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